

REMARKS

Claims 1 and 11 have been amended. Claims 7, 9-10 and 12 have been withdrawn. Claims 5 and 22-44 have been canceled. No new subject matter has been added. With entry of this Amendment, claims 1-4 and 6-21 are pending in the application.

Applicant wishes to thank the Examiner for noting during the telephonic interview that the reference cited in the Office action should be DeLong et al. (WO 99/12898) instead of Wos et al. (WO 99/12895). The change is reflected in the remarks provided below.

Applicant believes that the present Amendments, and accompanying Remarks, have placed the present Application in condition for allowance. Accordingly, timely and favorable action is respectfully requested.

Dependent Claim 5

Claim 5 was objected to under 37 C.F.R. §1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 5 was also rejected under 35 U.S.C. §102(b) as being anticipated by PCT Application Number WO 99/12898 to deLong et al. (“deLong”).

Claim 5 has been canceled. Therefore, Applicant respectfully requests removal of the objection and rejection to claim 5.

Independent Claim 1 and Dependent Claims 1-4, 6, 8, 11, and 13-21

The Examiner rejected independent claim 1 under 35 U.S.C. §103(a) as being obvious in view of deLong.

In order for the Examiner to establish a *prima facie* case of obviousness: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the teachings; 2) there must be a reasonable expectation of success; and 3) the references must teach or suggest all of the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on Applicant’s disclosure. *In Vaeck*, 947 F. 2d 422, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully traverses each of the rejections in view of the Examiner having failed to establish a *prima facie* case of obviousness for the reasons set forth below.

Applicant has amended claim 1 to remove “oxygen atom” from the definition of Y. Accordingly, “Y is selected from the group consisting of a divalent hydrocarbon group, a sulfur-containing moiety, and a nitrogen-containing group.” In contrast, the corresponding position in the compounds of Wos is occupied by an oxygen atom. Page 6 of the Specification. Therefore, Wos does not teach or suggest the subject matter of independent claim 1.

Dependent claim 11 has also been amended to remove “oxygen atom” from the definition of Y. Accordingly, claim 11 recites that “Y is selected from the group consisting of a sulfur atom, S(O), and S(O)₂.

With these amendments, reconsideration and withdrawal of the rejection to claim 1 are respectfully requested.

Dependent claims 2-4, 6, 8, 11, 13-21 depend from claim 1, and therefore, are allowable. In addition, these claims may contain additional patentable subject matter for reasons not delineated herein. Reconsideration and allowance of these claims are respectfully requested.

CONCLUSION

In view of the foregoing, consideration and allowance of claims 1-4, 6, 8, 11 and 13-21 are respectfully requested. The Examiner is strongly encouraged to contact the undersigned by telephone at the Examiner’s convenience should any issues remain.

Respectfully submitted,



Gregory J. Hartwig
Reg. No. 46,761

Docket No.: 028193-9010-01
Michael Best & Friedrich LLP
100 East Wisconsin Avenue
Milwaukee, Wisconsin 53202-4108
(414) 271-6560